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TREK BICYCLE CORPORATION

**UNITED STATES DISTRICT COURT**  
**CENTRAL DISTRICT OF CALIFORNIA**

MAKE HIM SMILE, INC., a  
California corporation,

Plaintiff,

v.

TREK BICYCLE CORPORATION, a  
Wisconsin corporation; and DOES 1  
through 1000, inclusive,

Defendants.

Case No.: 2:17-cv-07136-RGK (KS)

**DEFENDANT TREK BICYCLE  
CORPORATION'S NOTICE OF  
MOTION AND MOTION TO  
DISMISS COMPLAINT;  
MEMORANDUM OF  
AUTHORITIES IN SUPPORT  
THEREOF**

Date: December 18, 2017  
Time: 9:00 a.m.  
Judge: Hon. R. Gary Klausner  
Location: Courtroom 850

1 TO THE COURT, ALL INTERESTED PARTIES AND THEIR ATTORNEYS OF  
2 RECORD:

3 PLEASE TAKE NOTICE THAT on December 18, 2017, at 9:00 a.m., or as  
4 soon thereafter as the matter may be heard, in Courtroom 850 of the United States  
5 District Courthouse, 255 East Temple Street, Los Angeles, California 90012, before  
6 the Honorable R. Gary Klausner, Defendant Trek Bicycle Corporation (“Trek”) will, and hereby does, move this Court for an order dismissing Plaintiff Make Him  
7 Smile, Inc.’s (“Plaintiff”) Complaint (the “Complaint”). This Motion is made  
8 pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure on the grounds  
9 that the Complaint fails to allege facts sufficient to state any claim upon which  
10 relief can be granted—Plaintiff cannot maintain a right of publicity claim under  
11 California law, or a derivative California Unfair Competition Law claim, because  
12 Chris Farley had no such rights when he died as a domiciliary of Illinois; Plaintiff  
13 cannot maintain a Lanham Act claim since it fails to allege that Trek used a  
14 distinctive attribute of Chris Farley; and in any event Trek’s alleged use would  
15 amount to a nominative fair use and therefore is not actionable.  
16

17 This Motion is based upon this Notice, the accompanying Memorandum of  
18 Points and Authorities and Request for Judicial Notice, any reply memorandum, the  
19 filings in this action, and such other matters as may be presented at or before the  
20 hearing.

21 This Motion is made following the conference of counsel pursuant to Local  
22 Rule 7-3, which took place on November 6, 2017.  
23  
24  
25  
26  
27  
28

1 DATED: November 13, 2017

**PERKINS COIE LLP**

3 By: /s/ Michael B. Garfinkel

4 Michael B. Garfinkel

Oliver M. Gold

5 Attorneys for Defendant  
6 Trek Bicycle Corporation  
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## MEMORANDUM OF POINTS AND AUTHORITIES

### I. INTRODUCTION

Plaintiff Make Him Smile, Inc. (“Plaintiff”) is the alleged successor-in-interest to the intellectual property rights of deceased comedian Chris Farley, the so called “Farley IP.” (Complaint, ECF No. 1 (“Compl.”), ¶¶ 1, 13). According to Plaintiff, Chris Farley was overweight “his entire adult life,” “spent his entire career building, then capitalizing on his unique brand of ‘fat guy’ humor and acting style” and died weighing 400 pounds in 1997 at the age of 33. (*Id.*, ¶ 16). Nearly twenty years after his death, in June 2017, Plaintiff filed a registration with the California Secretary of State purporting to be the “successor-in-interest” to Chris Farley’s right of publicity under California Civil Code Section 3344.1. (*See* Request for Judicial Notice (“RJN”), Ex. D).<sup>1</sup>

Just a few months after registration, Plaintiff filed suit against Defendant Trek Bicycle Corporation (“Trek”), a Wisconsin bicycle company. One of the many products sold by Trek is a performance bike called a “fat bike,” an industry term for a type off-road bicycle with wider chassis and tires, making it more agile and adept at traversing unpaved terrain. (*Id.* ¶ 10). Trek calls its “fat bike” model “Farley.” (*Id.*). In its Complaint, Plaintiff claims that Trek’s selection of the name “Farley” infringes Plaintiff’s purported “Farley IP.” (*Id.*, ¶¶ 25-30). Importantly, Plaintiff does not allege Trek used the name “Chris Farley,” Chris Farley’s likeness, or any other distinctive attribute of Chris Farley on or in connection with the sale of these bikes. Instead, Plaintiff merely alleges that Trek selected “Farley” as a “hook” to associate with Chris Farley. (*Id.*, ¶ 25). This is insufficient as a matter of

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<sup>1</sup> Although Plaintiff makes conclusory allegations regarding its ownership of “Farley IP,” the Complaint lacks factual allegations supporting the existence or its exploitation of any such intellectual property rights. Plaintiff does not disclose that, or explain why, it waited *nearly twenty years* after Chris Farley’s death to file its California registration in June 2017. In any event, as explained below, the filing of a registration under Section 3344.1 does not create any intellectual property rights.

1 law. Even assuming, as the Court must on a motion to dismiss, that Trek named its  
2 fat bike model “Farley” as a nod to Chris Farley, Plaintiff has not and cannot allege  
3 a cognizable claim for at least three reasons.

4 First, Plaintiff’s California right of publicity claims fail because Chris Farley  
5 had no such rights to devise or assign. (*See id.*, ¶¶ 38–56 (asserting claims under  
6 the common law and Civil Code section 3344.1)). In no event can Plaintiff  
7 maintain a claim based on Chris Farley’s alleged California common law right of  
8 publicity because it is simply not descendible. *See Lugosi v. Universal Pictures*, 25  
9 Cal. 3d 813 (1979). Plaintiff also cannot maintain a claim under Civil Code section  
10 3344.1—California’s statutory, descendible right of publicity—because that  
11 statutory right is only available to personalities domiciled in California at the time  
12 of death. *See Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1149 (9th Cir. 2002).  
13 Plaintiff’s conclusory allegation that Chris Farley died a California domiciliary is  
14 directly contradicted by judicially noticeable Illinois probate records in which Chris  
15 Farley’s parents declare under oath that he died as a resident of Chicago, Cook  
16 County, Illinois. Not only should Plaintiff’s contradictory allegations be  
17 disregarded, but Plaintiff is also judicially estopped from asserting a Section 3344.1  
18 claim.<sup>2</sup> *See Milton H. Greene Archives, Inc. v. Marilyn Monroe LLC*, 692 F.3d 983  
19 (9th Cir. 2012). Without that claim, Plaintiff’s derivative California Unfair  
20 Competition Law claim necessarily falls, as well. (*See Compl.*, ¶¶ 67–71).

21 Second, Plaintiff’s false endorsement claim under the Lanham Act cannot  
22 survive this motion because Trek is not alleged to have used a distinctive attribute  
23 of Chris Farley’s identity. *See Waits v. Frito-Lay*, 978 F.2d 1093 (9th Cir. 1992),  
24 *abrogated by Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 134 S. Ct.  
25 1377 (2014). Plaintiff alleges only that Trek used the name “Farley” in connection  
26

27 \_\_\_\_\_  
28 <sup>2</sup> Illinois’s statutory descendible right of publicity was enacted after Chris Farley’s  
death and is expressly not retroactive. *See* 765 Ill. Comp. Stat. 1075, *et seq.*

1 with its bike model. Plaintiff does not allege that Trek used the name “Chris  
2 Farley” or any other uniquely distinguishing characteristic, such as his likeness or  
3 alleged “fat guy” character, on or in connection with the sale of such bikes.  
4 Plaintiff also does not allege that it or Chris Farley ever used the name “Farley” as a  
5 source identifier or that there is an association between Chris Farley and  
6 performance bikes. Plaintiff’s conclusory allegation that the surname “Farley” is  
7 synonymous with Chris Farley is insufficient and also negated by its allegation that  
8 his “friends and colleagues”—not his fans or the consuming public—called him  
9 “Farley.”

10 Third, the Lanham Act claim is also defeated by the nominative fair use  
11 defense. The nominative fair use analysis is appropriate where, as here, a defendant  
12 is alleged to have used the plaintiff’s alleged mark (“Farley”) to describe the  
13 plaintiff’s alleged product (Chris Farley), even if the defendant’s ultimate goal is to  
14 describe its own product (Trek bikes). *See Cairns*, 292 F.3d at 1151. Even  
15 assuming for the purposes of this motion that “Farley” was a distinctive mark  
16 identifying Chris Farley and that Trek selected the name in reference to him, Trek’s  
17 alleged use would constitute a nominative fair use because: (1) Chris Farley is not  
18 readily identifiable without the use of at least his name; (2) Trek is alleged to have  
19 used only so much of the alleged mark as reasonably necessary to identify Chris  
20 Farley (only his last name); and (3) Plaintiff has not alleged that Trek did anything  
21 that would, in conjunction with the use of the alleged Farley mark, suggest  
22 sponsorship or endorsement. Trek’s conduct would thus not implicate a source-  
23 identifying purpose and therefore is not actionable.

24 Finally, since amendment would be futile, the Court should dismiss the entire  
25 Complaint with prejudice.

## 26 II. SUMMARY OF COMPLAINT

27 On September 11, 2017, Plaintiff commenced this action by filing its  
28 complaint (the “Complaint”) in the California Superior Court, County of Los

1 Angeles, Case No. BC675506. (Dkt. 1-1). Trek removed the action to this Court  
 2 on September 27, 2017. (Dkt. 1). The Complaint purports to allege four claims  
 3 against Trek for: (1) California Common Law Misappropriation; (2) Violation of  
 4 California Civil Code section 3344.1; (3) False Endorsement in Violation of  
 5 Lanham Act, 15 U.S.C. section 1125(a); and (4) Unfair Business Practices in  
 6 Violation of California Business and Professions Code section 17200 (the “UCL”  
 7 or “Section 17200”). (*Id.*). The allegations are summarized below.

8 **1. Chris Farley.**

9 Chris Farley was a comedian who portrayed “fat and loud” characters on  
 10 NBC’s *Saturday Night Live*, and in films such as *Tommy Boy*, *Black Sheep*, and  
 11 *Beverly Hills Ninja*. (Compl., ¶ 14). According to Plaintiff, “[Chris] Farley  
 12 developed and refined an unapologetic Midwestern ‘fat-guy’ persona. When  
 13 advised by doctors to lose weight throughout the last years of his life, he had  
 14 legitimate concerns that doing so could jeopardize his ability to get roles and dilute  
 15 his brand as a comedian.” (*Id.*, ¶ 19). Chris Farley died at the age of 33, on  
 16 December 18, 1997. (*Id.*, ¶¶ 14, 16). Chris Farley was overweight “his entire adult  
 17 life,” and “weighed approximately 400 pounds” at death. (*Id.*, ¶¶ 1, 16).

18 **2. Plaintiff and the “Farley IP.”**

19 Plaintiff claims to be “the legal successor-in-interest, as such term is defined  
 20 under California law, to the estate of, and the property rights formerly owned by,  
 21 Chris Farley, who his friends and colleagues simply referred to as ‘Farley’  
 22 (‘Farley’).” (Compl., ¶¶ 1, 12). Yet, Plaintiff waited until June 20, 2017, nearly  
 23 twenty years after Chris Farley’s death and just months before filing this lawsuit, to  
 24 file a Registration of Claim as Successor-In-Interest (Civil Code section 3344.1)  
 25 with the California Secretary of State. (*See id.*, ¶ 13; *see also* RJN, Ex. D).

26 Plaintiff does not allege that it or anyone else holds a registered trademark in  
 27 the name “Chris Farley” let alone the surname “Farley.” Nonetheless, Plaintiff  
 28 alleges it is in the business of exploiting or licensing to third parties the rights to use

Chris Farley’s “name, likeness, image, voice, persona, signature, and other intellectual property comprising [Chris] Farley’s personal attributes,” defined as “the ‘Farley IP.’” (*Id.*). Plaintiff alleges that the “Farley IP” is recognized instantly by the general public and have substantial commercial value due to [Chris] Farley’s carefully crafting his identity as a comedian when he was alive, and the third parties’ and Plaintiff’s posthumous authorized publication, marketing, and other exploitation of [the] Farley IP.” (*Id.*, ¶ 15). According to Plaintiff, “the word ‘Farley’ has become iconic and narrowly associated with [Chris] Farley’s individual identity, comedic brand, and his loud, Midwestern, ‘fat-guy’ common man roots in Madison, Wisconsin.” (*Id.*, ¶ 20). Plaintiff also concludes that a “specific and targeted generation of consumers that tend to purchase Fat Bikes,” associate Chris Farley with “‘loud,’ ‘fat,’ [and] ‘Midwestern.’” (*Id.*, ¶ 29).

### 3. Defendant and Its “Farley” Bike Model.

Defendant Trek is “the largest bicycle manufacturer in North America,” and “one of the world’s five largest bicycle manufacturers.” (Compl., ¶ 9). Among the many products that Trek designs, manufactures, and sells is a model of “fat bikes.” In the industry, “fat bikes” generically refer to bikes with “attributes that make them more agile and adept at traversing unpaved terrains.” (*Id.*, ¶ 10).

According to Plaintiff, Trek’s fat bikes prominently feature the name “Farley.” (*Id.*, ¶ 10, 11). Plaintiff alleges that Trek selected the name to create instant name recognition between its fat bike products and Chris Farley—an “advertising and branding ‘hook’ to help launch and promote sales of each of its various Fat Bike products” and to “welcome and encourage potential customers and the bike industry generally to immediately associate . . . Trek’s Fat Bikes with one of their favorite famous ‘fat’ and ‘loud’ comedians.” (*Id.*, ¶¶ 25, 27, 28).

Finally, Plaintiff alleges in conclusory terms that “Trek’s top level executives,” have spoken and cooperated with the writers of bicycle trade articles and product reviews, and have never sought to correct the record, “which routinely

1 include[s] statements that the Farley Branded Products were . . . inspired by, and  
 2 named after, [Chris] Farley.” (*Id.*, ¶ 33). Plaintiff also claims that it suffered  
 3 damages due to the fact that Trek recalled about 2,600 Trek Farley bicycles due to a  
 4 potential fall hazard to the rider. (*Id.*, ¶ 35).

### 5 III. LEGAL STANDARD

6 To survive a motion to dismiss under Federal Rule of Civil Procedure  
 7 12(b)(6), a plaintiff’s factual allegations “must be enough to raise a right to relief  
 8 above the speculative level . . . .” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555,  
 9 (2007). The allegations must “plausibly suggest[,]” and not merely be consistent  
 10 with, the claimed wrongful conduct. *Id.*, at 557. The court may dismiss a  
 11 complaint as a matter of law for: (1) “lack of cognizable legal theory” or (2)  
 12 “insufficient facts under a cognizable legal claim.” *SmileCare Dental Grp. v. Delta*  
 13 *Dental Plan of Cal. Inc.*, 88 F.3d 780, 783 (9th Cir. 1996) (citation omitted).

14 Factual allegations are assumed true, but the plaintiff must provide “more  
 15 than labels and conclusions, and a formulaic recitation of the elements of a cause of  
 16 action.” *Twombly*, 550 U.S. at 555. Courts are “not bound to accept as true a legal  
 17 conclusion couched as a factual allegation,” and “(t)hreadbare recitals of the  
 18 elements of a cause of action, supported by mere conclusory statements, do not  
 19 suffice.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). It is improper to assume “the  
 20 (plaintiff) can prove facts that it has not alleged.” *Associated Gen. Contractors of*  
 21 *Cal., Inc. v. Cal. State Council of Carpenters*, 459 U.S. 519, 526 (1983).

### 22 IV. ARGUMENT

#### 23 A. Plaintiff’s Claims for Violation of California’s Rights of Publicity 24 Necessarily Fail Because the Common Law Right Is Not Descendible and 25 the Statutory Right under Civil Code section 3344.1 Is Not Available to 26 Chris Farley Who Died an Illinois Domiciliary.

27 Plaintiff attempts to allege two right of publicity claims under California  
 28 law—violation of California’s common law right of publicity (Compl., ¶¶ 38–47)

1 and Civil Code section 3344.1 (*id.*, ¶¶ 49–56). Both claims fail as a matter of law  
 2 because the common law right is not descendible and Chris Farley had no statutory  
 3 publicity right having died domiciled in Illinois, not California.

4           1.       **Chris Farley Does Not Have a Common Law Right of Publicity**  
 5                   **Under California Law Because It Is Not Descendible.**

6           Plaintiff cannot assert a claim based on Chris Farley’s California common  
 7 law right of publicity because it is not descendible.

8           California’s statutory right of publicity originated with the enactment of Civil  
 9 Code section 3344, which authorized the recovery of damages by any living person  
 10 whose name, photograph, or likeness has been used for commercial purposes  
 11 without his or her consent. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25  
 12 Cal. 4th 387 (2001). In *Lugosi v. Universal Pictures*, 25 Cal. 3d 813 (1979), the  
 13 California Supreme Court recognized a complementary common law right of  
 14 publicity, but held that since it is derived from the law of privacy, it is not freely  
 15 transferable or descendible and expires by operation of law at death. *Id.* at 824. In  
 16 response, the California legislature enacted Civil Code section 990 creating a  
 17 descendible right of publicity, which the legislature subsequently amended and  
 18 renamed Section 3344.1.

19           In *Lugosi*, the California Supreme Court made clear that there is no  
 20 descendible common law right of publicity in California. Therefore, Plaintiff  
 21 cannot assert a claim based on Chris Farley’s post-mortem common law right of  
 22 publicity and its claim attempting to do so fails as a matter of law.

23           2.       **Plaintiff Cannot Assert a Section 3344.1 Claim Because It Is Only**  
 24                   **Available to Personalities Who Die Domiciled in California, and**  
                   **Chris Farley Died Domiciled in Illinois.**

25           Plaintiff also cannot assert a claim under California Civil Code Section  
 26 3344.1 because Chris Farley died as an Illinois domiciliary.

27           Section 3344.1 prohibits the use of a deceased personality’s name, voice,  
 28 signature, photograph or likeness on or in products, merchandise or goods, or for

1 the purpose of selling, or soliciting purchases of products, merchandise, goods or  
 2 services without prior consent. However, Section 3344.1 is only available to those  
 3 personalities who die while domiciled in California. *Cairns*, 292 F.3d 1139  
 4 (holding Princess Diana died a domiciliary of Great Britain and therefore could not  
 5 assert a claim under Section 3344.1); *Milton H. Greene Archives, Inc.*, 692 F.3d  
 6 983 (holding Marilyn Monroe died domiciled in New York and there is no  
 7 descendible right of publicity under New York law).

8 In an attempt to avail itself of Section 3344.1, Plaintiff alleges that Chris  
 9 Farley “was domiciled in the State of California, County of Los Angeles” at the  
 10 time of his death. (Compl., ¶ 14). However, the Court should disregard this  
 11 allegation because it is directly contradicted by Chris Farley’s judicially noticeable  
 12 Illinois probate records. “The Court may disregard allegations in a complaint that  
 13 are contradicted by matters properly subject to judicial notice.” *Headspace Int’l,*  
 14 *LLC v. New Gen Agric. Servs., LLC*, No. CV-16-3917-RGK (GJSx), 2016 WL  
 15 9275781, at \*2 (C.D. Cal. Nov. 15, 2016) (Klausner, J.); *Steckman v. Hart Brewing,*  
 16 *Inc.*, 143 F.3d 1293, 1295-96 (9th Cir. 1998). Public records, such as filings in  
 17 probate court proceedings, are routinely considered for this purpose.<sup>3</sup> *See, e.g., In*  
 18 *re Tower Park Properties, LLC*, 803 F.3d 450, 452 (9th Cir. 2015) (taking judicial  
 19 notice of documents filed in probate court proceedings); *United States v. Paulson*,  
 20 204 F. Supp. 3d 1102, 1108 (S.D. Cal. 2016) (same).

21 Chris Farley’s Illinois probate records establish that he was domiciled in  
 22 Illinois at the time of death. On January 21, 2008, Chris Farley’s mother, Mary  
 23 Anne Farley initiated the Illinois probate by filing a Petition for Letters of  
 24

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25 <sup>3</sup> It is well established that on a motion to dismiss, a court can consider documents  
 26 that may be judicially noticed such as documents in the public record. *MGIC*  
 27 *Indem. Corp. v. Weisman*, 803 F.2d 500, 504 (9th Cir. 1986) (noting that a district  
 28 court may take “judicial notice of matters of public record outside the pleadings”  
 when determining whether a complaint fails to state a claim).

1 Administration in the Circuit Court of the Cook County, Illinois County  
2 Department – Probate Division. (RJN, Ex. A). Mary Anne Farley also served as  
3 the CEO of Plaintiff, and remains a director. (RJN, Ex. E). Under penalty of  
4 perjury, Ms. Farley’s Petition declared: “CHRISTOPHER C. FARLEY, whose  
5 place of residence at the time of death was 875 North Michigan Avenue, Chicago,  
6 Cook County, Illinois, died DECEMBER 18, 1997, at Chicago, Illinois leaving no  
7 will.” (RJN, Ex. A) The Petition further stated that the approximate value of the  
8 estate is \$5,000,000 in personal property and \$0 in real property or annual income  
9 from real estate. (*Id.*) Pursuant to the Petition, Chris Farley’s father, Thomas J.  
10 Farley, was appointed as the independent administrator of his estate and he also  
11 declared under penalty of perjury that Chris Farley “died a resident of Cook  
12 County, Illinois on December 18, 1997 at the age of 33 years.” (*See* RJN, Ex. B).

13 The terms “residence” and “domicile” are used synonymously under the  
14 Illinois Probate Act. *In re Estate of Elson*, 120 Ill. App. 3d 649, 653–54 (1983).  
15 Moreover, since the Petition states that Chris Farley had no Illinois real property at  
16 the time of death, he necessarily had to be an Illinois domiciliary in order for the  
17 probate to be administered in Illinois. *See id.* (“An Illinois circuit court in probate  
18 may exercise jurisdiction over the estate of a decedent either when the deceased  
19 was domiciled in Illinois or at the time of her death owned property in this State.”).  
20 Thus, the sworn statements of Chris Farley’s parents as probate petitioner and  
21 administrator establish that Chris Farley died as a domiciliary of Illinois. Plaintiff  
22 is therefore judicially estopped from inconsistently asserting that Chris Farley died  
23 a domiciliary of California in order to assert a Section 3344.1 claim. *See Milton H.*  
24 *Greene Archives, Inc.*, 692 F.3d at 1000 (judicially estopped Marilyn Monroe, LLC  
25 and its licensee from pursuing Section 3344.1 rights because her representatives  
26 previously took the position that she was domiciled in New York at death).

27 Plaintiff’s Section 3344.1 claim is not saved by the fact that it registered a  
28 claim of rights as successor-in-interest to Chris Farley’s property rights with the

1 California Secretary of State. (*See* Compl., ¶13). The filing of a registration does  
 2 not create any rights where none exist. Rather, subsection (f) explains that it is a  
 3 prerequisite to recovering damages and results in a public record of the filer's  
 4 claim. Indeed, the Secretary of State's database of such filings expressly disclaims  
 5 the "accuracy, adequacy, completeness, legality, reliability or usefulness of any  
 6 information so provided" and makes clear it posts the filings on an "as is" basis.  
 7 (RJN, Ex. C.) Curiously, Plaintiff's Complaint does not disclose that it filed the  
 8 Section 3344.1 registration on June 20, 2017, nearly twenty years after Chris  
 9 Farley's death and just a few months before filing its Complaint. (RJN, Ex. D). In  
 10 any event, the filing of this registration does not change the judicially noticeable  
 11 fact that Chris Farley died a domiciliary of Illinois and therefore had no Section  
 12 3344.1 rights.

13           **3. Amendment Would Be Futile Because Chris Farley Also Has No**  
 14           **Rights of Publicity Under Illinois Law.**

15           Plaintiff cannot cure its right of publicity claims because Chris Farley did not  
 16 have any post-mortem right of publicity under Illinois law.

17           At the time Chris Farley died, Illinois did not recognize a descendible right of  
 18 publicity. Illinois' right of publicity statute, the Right of Publicity Act (the "Illinois  
 19 Act"), is codified at 765 Ill. Comp. Stat. 1075 and went into effect on January 1,  
 20 1999. Prior to enactment, there was no Illinois law that provided such a right after  
 21 death. *Carlson v. Del Pub. Co.*, 65 Ill. App. 2d 209 (1965). The Illinois Act  
 22 created an individual's right of publicity (*see* 765 Ill. Comp. Stat. 1075/10), but  
 23 explicitly provides that it does not retroactively create such a right for individuals  
 24 who died prior to January 1, 1999. *Id.*, § 35 (stating "[t]his Act applies to acts or  
 25 events that take place after the effective date of this Act"); § 30 (requiring written  
 26 consent for use of an individual's identity for commercial purposes only if the  
 27 individual died after the effective date of the Act). Here, Plaintiff alleges,  
 28 consistent with the Illinois probate records, that Chris Farley died on December 18,

1 1997. Thus, Chris Farley did not have any Illinois post-mortem right of publicity to  
2 devise or assign. *See* 765 Ill. Comp. Stat. 1075, *et seq.*

3 Similarly, in *Cairns v. Franklin Mint Co.*, the Ninth Circuit held that the  
4 executors of the estate of Princess Diana and the trustees of her memorial fund had  
5 no claim under California Civil Code section 990 (Section 3344.1's predecessor)  
6 because she died as a domiciliary of a foreign jurisdiction that did not grant or  
7 recognize a descendible right of publicity. 292 F.3d at 1149. The Ninth Circuit  
8 examined the legislative history and affirmed the district court's determination that  
9 California's default personal property choice of law provision, Civil Code section  
10 946, applied to the post-mortem right of publicity and required the application of  
11 the law of the jurisdiction where the personality died. Since Great Britain did not  
12 recognize a post-mortem right of publicity, Princess Diana's estate did not include a  
13 right of publicity and the claim failed. *Id.*

14 Likewise in this case, because Chris Farley died domiciled in Illinois, the law  
15 of that state controls. He passed away on December 18, 1997, before the Illinois  
16 legislature enacted the Illinois Act on January 1, 1999, so Chris Farley never had a  
17 post-mortem right of publicity and, accordingly, could assign no such right to  
18 Plaintiff. Like Princess Diana's successors-in-interest, Plaintiff's Section 3344.1  
19 claim fails as a matter of law and must be dismissed without leave to amend.

20 **B. Plaintiff's Unfair Competition Claim Under Section 17200 Falls with Its**  
21 **Defective Statutory Right of Publicity Claim.**

22 Because Plaintiff's claim under California's Section 17200 is predicated  
23 upon its defective California statutory right of publicity claim, it also fails and  
24 should be dismissed. (Compl., ¶¶ 67–71).

25 Unfair competition in California is "any unlawful, unfair or fraudulent  
26 business act or practice and unfair, deceptive, untrue or misleading advertising."  
27 California Business and Professions Code § 17200.<sup>4</sup> Claims under the "unlawful"

28 <sup>4</sup> In order to have standing to assert a claim for violation of the UCL, Plaintiff must

1 prong of the UCL “borrow” from other statutes and are predicated upon  
 2 independent violations of law. *Cel-Tech Commc’ns, Inc. v. L.A. Cellular Tel. Co.*,  
 3 20 Cal. 4th 163, 180 (1999). Thus, to plead a claim under this prong, Plaintiff must  
 4 allege facts sufficient to demonstrate a violation of an underlying law. *People v.*  
 5 *McKale*, 25 Cal. 3d 626, 635 (1979).

6 In this case, the Complaint defectively alleges a violation under the  
 7 “unlawful” prong of Section 17200, based on Trek’s purported violation of Section  
 8 3344.1. For the reasons described above, Plaintiff’s Section 3344.1 claim fails as a  
 9 matter of law. (Compl., ¶ 68). Without alleging any additional facts to supplement  
 10 or differentiate this claim from its flawed statutory claim, Plaintiff charges that Trek  
 11 misappropriated Plaintiff’s purported “Farley IP,” which “constitute[s] wrongful  
 12 conduct and unlawful business practices, including conduct that violates California  
 13 Civil Code § 3344.1.” (*Id.*) But because Plaintiff’s Section 3344.1 claim fails as a  
 14 matter of law—owing to the fact that Illinois law dictates that Chris Farley had no  
 15 post-mortem right of publicity to assign to Plaintiff—so too must its claim under  
 16 the “unlawful” prong of the UCL, which is predicated on the same flawed analysis.

17 **C. Plaintiff’s Lanham Act False Endorsement Claim Fails Because Plaintiff**  
 18 **Does Not Allege the Requisite Use of a Distinctive Attribute, and, Even if**  
 19 **It Had, It Would Amount to a Nominative Fair Use.**

20 Finally, Plaintiff’s claim for false endorsement under the Lanham Act fails at  
 21 the pleadings stage for two principal reasons. (*See* Compl., ¶¶ 57–66). First,  
 22 Plaintiff fails to plead an essential element of this claim—specifically, that Trek  
 23 used a distinctive attribute of Chris Farley. Second, even assuming that Plaintiff  
 24 had standing to assert a claim under the Lanham Act, and taking the allegations of  
 25 the Complaint as true for purposes of this motion, the conduct alleged of Trek is  
 26 non-infringing nominative fair use.

27 allege that it suffered an injury in fact and lost money or property as a result of an  
 28 unfair, unlawful or fraudulent business practice. *See, e.g., In re Tobacco II Cases*,  
 46 Cal. 4th 298, 315 (2009).

1           **1. Plaintiff Fails to Allege that Trek Used a Distinctive Attribute of**  
 2           **Chris Farley.**

3           Plaintiff's Lanham Act claim is insufficient as a matter of law because the  
 4           name "Farley" is not a distinctive attribute of Chris Farley.

5           The Ninth Circuit recognizes a false endorsement claim under Section 43(a)  
 6           of the Lanham Act, 15 U.S.C. section 1125(a), for misuse of a celebrity persona.  
 7           *Fifty-Six Hope Road Music, Ltd. v. A.V.E.L.A., Inc.*, 778 F.3d 1059, 1068 (9th Cir.  
 8           2015) (owner of Bob Marley's property rights sued over use of his image on  
 9           competing t-shirts and other merchandise). In *Waits v. Frito-Lay, Inc.*, the Ninth  
 10          Circuit held as a matter of first impression "that a celebrity whose endorsement of a  
 11          product is implied through the imitation of a distinctive attribute of the celebrity's  
 12          identity, has standing to sue for false endorsement under section 43(a) of the  
 13          Lanham Act." 978 F.2d 1093, 1110 (9th Cir. 1992), *abrogated by Lexmark Int'l,*  
 14          *Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377 (2014). *Waits* has been  
 15          followed in cases such as *White v. Samsung Electronics America, Inc.*, 971 F.2d  
 16          1395, 1400–01 (9th Cir. 1992), where the court allowed Vanna White, the hostess  
 17          of "Wheel of Fortune," to bring a claim for use of a look-alike caricature robot  
 18          endorsing the defendant's product in an advertisement for VCRs.<sup>5</sup>

19          The *sine qua non* of a celebrity false endorsement claim is defendant's use or  
 20          imitation of a distinctive attribute of that celebrity. Here, Plaintiff is unable to  
 21          identify any such distinctive attribute that could support its claim. Plaintiff does not  
 22          allege that Trek used the name "Chris Farley," his likeness, or anything unique to  
 23

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24          <sup>5</sup> In *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996), plaintiff  
 25          basketball legend Kareem Abdul-Jabbar brought a Lanham Act false endorsement  
 26          claim based on the use of his full given name "Lew Alcindor" and a unique statistic  
 27          about his college career as the answer to a trivia question in a car commercial. The  
 28          Ninth Circuit concluded that it was "far from clear" that it was a violation, but  
 rejected defendants' abandonment defense and held that there was a question of fact  
 for the jury as to whether defendants were entitled to a fair use defense.

1 his career. Plaintiff also does not allege that any attribute of Chris Farley appears  
2 on Trek's bikes or in advertising in a manner that suggests Chris Farley's  
3 endorsement. That explains why Plaintiff chose not to include any visual  
4 representations of Trek's fat bike or promotional material in its Complaint.

5 Instead, the best Plaintiff can muster is to vaguely allege that Trek, a  
6 Wisconsin company, named its fat bike model "Farley" as a "hook" to associate  
7 with Chris Farley and his "loud, fat and Midwestern" persona. (*See* Compl., ¶¶ 25-  
8 30). Plaintiff pins its Lanham Act claim on the premise that the surname "Farley"  
9 has become a distinct attribute of Chris Farley. Yet, Plaintiff does not, and cannot,  
10 allege even one instance where Chris Farley or Plaintiff used "Farley" as a source  
11 identifier for Chris Farley's persona or services. (*See generally* Compl.).  
12 Plaintiff's vague conclusion that "Farley" alone is "well-recognized, distinctive and  
13 unique and singularly associated with [Chris] Farley" is not corroborated by any  
14 factual allegations whatsoever. (*See id.*, ¶ 58) The Court is therefore not required  
15 to, and should not, accept it as true at this stage. *See Iqbal*, 556 U.S. at 678. In  
16 fact, Plaintiff's conclusory allegation is belied by its own concession that Chris  
17 Farley was referred to as "Farley" by his "friends and colleagues." (Compl., ¶ 12).

18 Further, Plaintiff's allegation that the word "Farley" alone is "distinctive"  
19 and "singularly associated with [Chris] Farley" is also directly contradicted by the  
20 judicially noticeable public records from Trek's registration of the mark with the  
21 United States Patent and Trademark Office ("U.S.P.T.O."). (*See* RJN, Ex. F). In  
22 2013, Trek filed a trademark application for the word mark "Farley" to be used on  
23 bikes and related products. The U.S.P.T.O. refused registration on the Principal  
24 Register "because the applied-for mark is primarily a surname." (*Id.*) As support,  
25 the U.S.P.T.O. stated that FARLEY is a common surname in the United States,  
26 appearing 11,172 times in a nationwide telephone directory, and gave examples of  
27 comedian Chris Farley; Christopher John Farley, a senior writer and pop music  
28 critic for Time Magazine; and Mark Farley, the head football coach at the

1 University of Northern Iowa. (*Id.*) Also considering there is no dictionary  
 2 definition of “Farley,” the U.S.P.T.O. concluded: “This is strong evidence that the  
 3 term FARLEY is primarily understood as merely a surname.” (*Id.*) As a result,  
 4 Trek registered “Farley” on the Supplemental Register.

5 Accordingly, Plaintiff has not alleged necessary facts that would allow it to  
 6 bring this Lanham Act claim, and based on the Complaint’s current allegations, it is  
 7 improper to assume that it can prove facts that it has not alleged. *See Ass’n Gen.*  
 8 *Contractors of Cal., Inc.*, 459 U.S. at 526.

9  
 10 **2. The Nominative Fair Use Defense Defeats Plaintiff’s False  
 Designation of Origin Claim.**

11 Plaintiff’s Lanham Act claim is also fatally flawed because even if Trek did  
 12 what Plaintiff alleges—name its fat bike model “Farley” as an homage to Chris  
 13 Farley—that conduct would amount to nothing more than a nominative fair use.

14 The nominative fair use analysis is appropriate where a defendant has used  
 15 the plaintiff’s mark to describe the plaintiff’s product or service, even if the  
 16 defendant’s ultimate goal is to describe his own product. *See Cairns*, 292 F.3d at  
 17 1151. To establish a nominative fair use defense, a defendant must prove the  
 18 following three elements: (1) the plaintiff’s product or service in question must be  
 19 one not readily identifiable without use of the trademark; (2) only so much of the  
 20 mark or marks may be used as is reasonably necessary to identify the plaintiff’s  
 21 product or service; and (3) the user must do nothing that would, in conjunction with  
 22 the mark, suggest sponsorship or endorsement by the trademark holder.  
 23 *See Adaptive Mktg. LLC v. Girard Gibbs LLP*, No. CV 09–04739 RGK (RCx),  
 24 2009 WL 8464168, at \*3 (C.D. Cal. Oct. 9, 2009) (Klausner, J.) (citing *Playboy*  
 25 *Enters., Inc. v. Netscape Commc’ns Corp.*, 354 F.3d 1020, 1029–30 (9th Cir. 2004);  
 26 *New Kids on the Block v. News Am. Publ’g., Inc.*, 971 F.2d 302, 308 (9th Cir.

1 1992)). Within the Ninth Circuit, the nominative fair use defense is available at the  
 2 pleadings stage and is applied to dispose of meritless claims at their incipency.<sup>6</sup>

3 The seminal Ninth Circuit opinion applying nominative fair use in this  
 4 context is *New Kids on the Block v. News American Publishing, Inc.*, 971 F.2d 302  
 5 (9th Cir. 1992). Plaintiff musical group The New Kids on the Block (“New Kids”)   
 6 brought suit against two newspapers that conducted separate reader polls seeking to  
 7 determine which member of the group was most popular. The announcements  
 8 asked readers to vote by placing a call to “900 numbers” for which the readers were  
 9 charged. New Kids alleged that these unauthorized polls implied their sponsorship,  
 10 asserting a variety of Lanham Act claims. The Ninth Circuit recognized that not all  
 11 uses of a trademark serve source-identifying functions and therefore a nominative  
 12 fair use of another’s mark is not actionable. *Id.* at 308. Otherwise, “[m]uch useful  
 13 social and commercial discourse would be all but impossible if speakers were under  
 14 threat of an infringement lawsuit every time they made reference to a person,  
 15 company or product by using its trademark.” *Id.* at 307.

16 Applying the articulated test, the Ninth Circuit concluded that the first  
 17 requirement was met because New Kids was not readily identifiable without the use  
 18 of the group’s name. *Id.* at 308. It concluded that it was no different than referring  
 19 to “Chicago Bulls” rather than “the [then] two-time world champions” or “the  
 20 professional basketball team from Chicago.” *Id.* at 306. The Ninth Circuit also  
 21 concluded that the second and third requirements were met because the references  
 22

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23 <sup>6</sup> See, e.g., *Adaptive Mktg. LLC*, 2009 WL 8464168 (dismissing Lanham Act claims  
 24 and finding the defendants’ use of the plaintiff’s mark to be nominative fair use);  
 25 *Beachbody, LLC v. Universal Nutrients, LLC*, No. CV 16-02015-R, 2016 WL  
 26 3912014, at \*2 (C.D. Cal. July 18, 2016) (same); *1800 GET THIN, LLC v. Hiltzik*,  
 27 No. CV11–00505 ODW (PJWx), 2011 WL 3206486, at \*2–3 (C.D. Cal. July 25,  
 28 2011) (same); *Architectural Mailboxes, LLC v. Epoch Design, LLC*, No. 10cv974  
 DMS (CAB), 2011 WL 1630809, at \*3–4 (S.D. Cal. Apr. 28, 2011) (same).

1 to New Kids were only to the extent necessary to identify them as the subject of the  
2 polls, and the announcements did nothing to suggest sponsorship, such as using  
3 their trademark. *Id.* at 308-9. The fact that the polls were “money-making  
4 enterprises separate and apart from the newspapers’ reporting businesses” did not  
5 deprive the newspapers of this defense. *Id.*

6 The nominative fair use doctrine as set forth in *New Kids* has been broadly  
7 applied in the Ninth Circuit to defeat Lanham Act claims. For example, in *Clark v.*  
8 *America Online Inc.*, No. CV-98-5650 CAS (CWx), 2000 WL 33535712 (C.D. Cal.  
9 Nov. 30, 2000), the court held that AOL’s reference to “Dick Clark” in an  
10 advertisement was a nominative fair use. The lawsuit centered around a  
11 promotional advertising mailer for AOL targeting members of the American  
12 Association of Retired Persons (“AARP”) with the hook: “If you danced to the  
13 Beatles, cruised in a Thunderbird, or tuned into Dick Clark, you have earned . . .  
14 100 hours free [Internet service on AOL].” *Id.* at \*1 Plaintiffs alleged that AOL’s  
15 use of the service mark “Dick Clark” in conjunction with the “American  
16 Bandstand”-type photograph violated the Lanham Act. *Id.* at \*2. But the court  
17 concluded that application of the *New Kids* test was appropriate because “this is a  
18 case ‘where the defendant uses a trademark [‘Dick Clark’] to describe the plaintiff’s  
19 product [Dick Clark, the historical figure], rather than its own.” *Id.* at \*5 (citing  
20 *New Kids*, 971 F.2d 308). The court held that the mailer satisfied the *New Kids* test  
21 and dismissed the Lanham Act claim.

22 Plaintiff’s allegation that Trek used “Farley” as the name of a product does  
23 not alter the analysis. For example, in *Cairns v. Franklin Mint Co.*, the Ninth  
24 Circuit applied the *New Kids* nominative fair use defense to Franklin Mint’s use of  
25 the late Princess Diana’s name and likeness on commercially sold jewelry, plates,  
26 and dolls, and in advertisements for those products. 292 F.3d at 1144. The first  
27 element of the *New Kids* test—that the plaintiff’s product must be one not readily  
28 identifiable without use of the trademark—was satisfied because while “one might

1 refer to ‘the English princess who died in a car crash in 1997,’ . . . it’s far simpler  
 2 (and more likely to be understood) to refer to ‘Princess Diana.’” *Id.* at 1153. The  
 3 second element—that only so much of the mark may be used as is reasonably  
 4 necessary to identify the plaintiff’s product or service—was also satisfied because  
 5 there was no allegation that Franklin Mint had “used any ‘distinctive lettering’ or  
 6 any particular image of Princess Diana intimately associated with” the plaintiff.<sup>7</sup>  
 7 Finally, the third element, which requires that “the user [] do nothing that would, in  
 8 conjunction with the mark, suggest sponsorship or endorsement by the trademark  
 9 holder,” was likewise met, mainly because none of Franklin Mint’s advertisements  
 10 for its Diana-related products claimed that the products were sponsored or endorsed  
 11 by the plaintiff. *Id.* at 1154.

12 The applicability of the nominative fair use defense is even stronger in this  
 13 case than in *Cairns*. Here, Plaintiff does not allege that Trek used the name “Chris  
 14 Farley,” Chris Farley’s likeness or any other distinctive attribute. (Compl., ¶¶ 25,  
 15 59). Instead, Plaintiff only alleges that Trek named one of its bike models “Farley”  
 16 in reference to Chris Farley. Even if this was true, Trek’s use of “Farley” would be  
 17 a non-infringing nominative fair use.

18 First, Plaintiff’s product or service in question—Chris Farley—is not readily  
 19 identifiable without at least a reference to his name. *See Cairns*, 292 F.3d at 1152–  
 20 53. Like the Franklin Mint’s reference to Princess Diana, while one may refer to  
 21 “the comedian and actor best known for his portrayal of ‘fat’ and ‘loud’ characters  
 22 on NBC’s *Saturday Night Live*, who died in 1997, weighing 400 pounds at the age  
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24  
 25 <sup>7</sup> *Cairns*, 292 F.3d at 1154 (distinguishing *Toho Co., Ltd. v. William Morrow &*  
 26 *Co., Inc.*, 33 F. Supp. 2d 1206, 1209, 1211 (C.D. Cal. 1998) (“holding that a  
 27 publisher who used the trademark “Godzilla” as the title of a book about the movie-  
 28 monster by the same name used more of the mark than was “reasonably necessary”  
 where “the title [was] written in the distinctive lettering style used by [the  
 trademark holder] and its licensees in their merchandising activities”).

1 of 33” (*See* Compl., ¶¶ 14, 16), it is far simpler (and more likely to be understood)  
2 to refer to Chris Farley. *Id.* Of course, here, Trek only referred to “Farley.”

3 Second, only so much of the purported mark has been used as is reasonably  
4 necessary to identify the Plaintiff’s product or service. In *Cairns*, the Ninth Circuit  
5 acknowledged that what is “reasonably necessary to identity the plaintiff’s product”  
6 differs from case to case, and distinguished cases like *Abdul-Jabbar v. General*  
7 *Motors Corp.*, 85 F.3d 407 (9th Cir. 1996), where the defendant used the plaintiff’s  
8 persona in advertising to call attention to its unrelated Oldsmobile Eighty-Eight.  
9 *Cairns*, 292 F.3d at 1154. In contrast, since the products in *Cairns* honored  
10 Princess Diana, Franklin Mint had to ensure that its customers understood the  
11 references and therefore it was “reasonably necessary” to have used the name  
12 “Princess Diana” and her likeness on and in advertising for the products. *Id.*  
13 Similarly here, Plaintiff alleges that Trek honored Chris Farley by naming its bike  
14 “Farley” based on their shared qualities of being “fat, loud, wide and Midwestern.”  
15 (*See* Compl., ¶ 29). Assuming that to be true, it would have been reasonably  
16 necessary for Trek to use his full name, but it only used “Farley.”

17 Third, the Complaint does not allege that Trek did anything that would, in  
18 conjunction with the use of the purported mark, suggest any sponsorship or  
19 endorsement by Chris Farley or Plaintiff. Trek’s logo, a registered trademark,  
20 served the source-identifying function on all of its products at issue, and there are  
21 no factual allegations that Trek’s advertisements have suggested that its Farley  
22 bikes are sponsored or endorsed by Chris Farley or Plaintiff. *See id.* at 1154.

23 Because Trek satisfies each element of the *New Kids* test, any alleged use of  
24 Farley in connection with its fat bikes constitutes non-infringing nominative fair  
25 use and the Lanham Act claim should be dismissed.

26 **D. Leave to Amend Is Not Warranted.**

27 The allegations in the Complaint demonstrate that any further amendment  
28 would be futile. A court may properly deny leave to amend where the amendment

1 would be futile. *See Foman v. Davis*, 371 U.S. 178, 182 (1962); *Gordon v. City of*  
2 *Oakland*, 627 F.3d 1092, 1094 (9th Cir. 2010).

### 3 V. CONCLUSION

4 Chris Farley died in 1997 as a domiciliary of Illinois and therefore Plaintiff  
5 does not have an enforceable right of publicity under California or Illinois law.  
6 Since Plaintiff's Section 17200 is predicated on an alleged violation of Section  
7 3344.1, it falls with it. Plaintiff also cannot plausibly allege a false endorsement  
8 claim because Trek did not use a distinctive attribute of Chris Farley in connection  
9 with its line of fat bikes. But even if it could, Trek's conduct would be a textbook  
10 example of nominative fair use. For these reasons, Defendant Trek Bicycle  
11 Corporation respectfully requests that the Court dismiss Plaintiff's Complaint in its  
12 entirety with prejudice.

13  
14 DATED: November 13, 2017

**PERKINS COIE LLP**

15  
16 By: /s/ Michael B. Garfinkel

17 Michael B. Garfinkel  
18 Oliver M. Gold

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20 Trek Bicycle Corporation  
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